

REMARKS

Reconsideration of the present application in view of the above amendments and following remarks is respectfully requested. Claims 55, 57, 58, and 61-64 are pending. As set forth above, Applicants have hereby amended claims 55, 58 and 61-64 to more clearly define the subject matter encompassed by the Applicants' invention, and claim 57 has been amended for editorial purposes only to correct an obvious inadvertent typographical error. No new matter has been added.

CLAIM OBJECTION

Claim 57 has been objected to because of informalities. More specifically, it is alleged that claim 57 is directed to a heavy chain variable region but recites sequences for both the heavy and light chain variable regions.

As an initial matter, Applicants wish to thank the Examiner for identifying this obvious inadvertent typographical error. In this regard, Applicants submit that claim 57 has been amended to refer to an immunoglobulin rather than a heavy chain. This amendment also provides the proper antecedent basis for claim 58. Therefore, claim 57 is directed to an isolated immunoglobulin having heavy and light chain variable regions encoded by SEQ ID NO:207 and SEQ ID NO:208, respectively.

Accordingly, Applicants respectfully submit that the objection to claim 57 has been obviated and, therefore, request that it be withdrawn.

REJECTION UNDER 35 U.S.C. §101

Claims 55, 58 and 61-64 were rejected under 35 U.S.C. §101, as directed to non-statutory subject matter. In particular, it is alleged that the claims read on antibodies made in the human body.

Applicants wish to thank the Examiner for suggesting language to address the instant rejection. Applicants hereby submit that this rejection has been rendered moot because claims 55, 58 and 61-64 have been amended to recite an "isolated" immunoglobulin.

Accordingly, Applicants respectfully submit that this rejection under 35 U.S.C. §101 has been overcome and, therefore, request that it be withdrawn.

REJECTION UNDER 35 U.S.C. §102(a)

In the Office Action, claims 55, 58, and 61-64 were rejected under 35 U.S.C. §102(a) as anticipated by Fishwild *et al.* (*Nature Biotechnology* 14:845-851, July 1996). In particular, it is alleged that Fishwild *et al.* disclose anti-CD4 monoclonal antibodies isolated from the same hybridomas disclosed in the instant specification.


Applicants respectfully traverse this ground of rejection and submit that Fishwild *et al.* is not prior art to the subject application. When Applicants are co-authors of a publication cited against their application, the cited publication can be removed as a reference under 35 U.S.C. §102(a) by a declaration by Applicants indicating that Applicants are the sole inventors and that the other authors were merely working under their direction (*see In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982); *see also* MPEP §715.01(c)(I)). In this regard, Applicants hereby submit a Correction of Inventorship, and all related documentation, to add Dianne M. Fishwild as an inventor in view of the claimed subject matter. In addition, Applicants hereby submit a Declaration of Nils Lonberg, Robert M. Kay, and Dianne M. Fishwild to remove the Fishwild *et al.* reference as prior art.

Accordingly, Applicants respectfully submit that the Fishwild *et al.* reference does not comply with the requirements of 35 U.S.C. §102(a) and, therefore, request that this rejection be withdrawn.

In view of the above amendments, Applicants believe the pending application is in condition for allowance. Favorable consideration and a Notice of Allowance are earnestly solicited. The Examiner is urged to contact the undersigned attorney if there are any questions prior to allowance of this matter.

Respectfully submitted,

Dated: May 16, 2005

By 
Jeffrey C. Pepe
Registration No.: 46,985

DARBY & DARBY P.C.
P.O. Box 5257
New York, New York 10150-5257
(206) 262-8900
(212) 753-6237 (Fax)
Attorneys/Agents For Applicant

Enclosures: Declaration of Nils Lonberg, Robert M. Kay, and Dianne M. Fishwild
Request to Correct Inventorship
Statement of Dianne M. Fishwild
Consent of Assignee
Statement under 37 C.F.R. § 3.73(b)
Supplemental Declaration by Inventors
Copy of Assignment from Dianne M. Fishwild to GenPharm International, Inc.